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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,932	03/09/2001	Larry L. Lu	06975-127001	3453
26171	7590	01/25/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ARANI, TAGHI T	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/801,932	<b>Applicant(s)</b> LU, LARRY L.	
	<b>Examiner</b> Taghi T. Arani	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 78-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-77 have been cancelled.

Claims 78-116 are pending.

2. **Reopening of Prosecution - New Ground of Rejection After Appeal**

In view of the Appeal Brief filed on 11/08/2005 and the recommendation of Supervisory Examiner and the Primary Examiner in the group art unit, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 ; or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. **Claims 78-82, 84-87, 90-94, 95, 97-100, 103-108, 110-113 and 116** are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art of record, Dieterman (US 6,393,464) and further in view of Heiner (US patent 6,112,227).

**As per claims 78, 87, 91, 100, 104 and 113**, Dieterman teaches method, system and computer program for monitoring electronic messages that are directed to an intended recipient, the method comprising [abstract, see also col. 3, lines 20-33]:

establishing a supervisory relationship between a supervisory recipient and an intended recipient [Fig. 5 and associated text, col. 3, lines 34-42, account administrator (i.e. a supervisory recipient) establishes and maintains a list of allowed senders and recipients within client email terminal 10 and in database 13 which is accessible to ISP computer 12];

receiving electronic messages (**and emails recited in claims 87, 99 and 112**) transmitted across a delivery network from one or more sender devices and directed to the intended recipient [col. 5, lines 24-45];

delivering a first one of the electronic messages to the supervisory recipient [col. 5, lines 24-30];

enabling the supervisory recipient to review and approve the first electronic message after the first electronic message has been delivered to the supervisory recipient [col. 4, lines 30-46, col. 5, see also Fig. 19 and corresponding text]; and

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enabling notification of the first electronic message to be provided to the intended recipient only if the supervisory recipient approves the first electronic message [col. 5, lines 41-45, Dieterman teaches if approval is granted, the email message is placed in the normal inbox (i.e. is the intended recipient is notified)).

Dieterman is silent in disclosing delivering a first one of the electronic messages to the supervisory recipient without notifying the intended recipient that the first electronic message has been delivered to the supervisory recipient;

However, in an analogous art, Heiner teaches delivering a first one of the electronic messages to the supervisory recipient without notifying the intended recipient that the first electronic message has been delivered to the supervisory recipient (Figure 2, elements 80,100 and 110, col. 3, lines 5-38, where the destination SMTP server determines whether the source client is on the accept or reject lists and if the source client is on the reject list, the e-mail message is deleted).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dieterman's delivery of the electronic mail messages with the teachings of Hinter's delivery of the electronic mail messages without notifying the intended recipient that the electronic message has been delivered to the supervisory recipient with a motivation to filter-out the junk e-mail messages received by the destination client and to reduce the amount of time spend by the destination client separating their regular e-mail messages from unwanted e-mail messages ( Heiner, col.1, lines 10-30).

**As per claims 79-81, 92-94, and 105-107,** Dieterman teach that the sending of messages by a user and viewing of messages received by a user (i.e. an intended recipient) are controlled

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by an account administrator (i.e. a supervisory recipient) who establishes and maintains a list of allowed senders and recipients of messages [col. 3, lines 34-42, account administrator (i.e. a supervisory recipient) establishes and maintains a list of allowed senders and recipients within client email terminal 10 and in database 13 which is accessible to ISP computer 12 (see also col. 3, lines 34-38). That is, a supervisory recipient for the intended recipient is established and maintained in a database accessible to the ISP. Dieterman further teaches that the user may be a child having an email account established with the ISP and the account administrator is the child's parent or guardian [Dieterman col. 1, lines 65-67]. This suggests the intended recipient and the supervisory recipient have related accounts and screen names. Such relationship holds between electronic message address of an employer with an electronic message address of an employee (i.e. associating an electronic message addresses of the supervisory recipient with an electronic message address of the intended recipient).

**As per claims 82, 95 and 108**, Dieterman teaches examining a header of the first electronic message to determine whether the header includes the electronic message address of the intended recipient [Fig. 11, FROM, TO and CC header elements];

determining the electronic address of the supervisory recipient associated with the electronic message address of the intended recipient; and

routing the first electronic message to the electronic message address of the supervisory recipient [col. 5, lines 35-46, i.e. if the identity of the sender of an email is determined to not appear on the allowed list, the incoming message is designated as a message requiring approval, and is placed in the inbox for message requiring approval].

**As per claims 84, 97 and 110**, Dieterman teaches:

examining a header of a second one of the electronic messages to determine an electronic address of the sender of the second electronic message [Fig. 5, elements 51-53, ISP receives emails addressed to user (i.e. a plurality of electronic messages)].

comparing the determined electronic address of the second electronic message to at least one sender list [Fig 5, element 53, sender address compared with the allowed list], and

approving or rejecting the electronic message based on a result of the comparison { Fig. 5, elements 59, 60-61 and 55}.

**As per claims 85, 98 and 111**, Dieterman teaches that the at least one sender list includes a list of approved senders such that the comparing module compares the determined electronic address to the list of approved senders [co. 2, lines 1-19, Dieterman teaches a list of allowed addresses with whom the user is permitted to freely exchange messages, col. 5, lines 30-35].

**As per claims 86 , 99 and 112**, Dieterman teaches each message sent by or sent to the user will be categorized as either authorized if the other party to the communication appears on the allowed list, or unauthorized (i.e. blocked sender) if the other party does not appear on the allowed list and that outgoing messages that are not authorized will not be transmitted (i.e. will be blocked), see col. 2, lines 1-11].

**5. Claims 90, 103 and 116** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieterman (US 6,393,464) and further in view of Heiner (US patent 6,112,227).

**As per claims 90, 103 and 116**, Dieterman teaches :

delivering a second one of the electronic messages to the supervisory recipient [ Fig. 5, element 51, ISP receives emails addressed to User (plurality of messages, see Fig.5 and associated text}); and

automatically forwarding or deleting the second electronic message if the supervisory recipient does not review and approve the second electronic message within a period of time after delivery of the second electronic message to the supervisory recipient [col. 5, lines 44-46, Dieterman teaches If the message is not approved by the administrator , it remains in the outbox for messages needing approval and will be erased after a predetermined amount of time if no approval is granted. That is, the intended recipient of the message is not notified].

Dieterman is silent in disclosing ‘without notifying the intended recipient that the second electronic message has been delivered to the supervisory recipient’.

However, in an analogous art, Heiner teaches delivering a second one of the electronic messages to the supervisory recipient without notifying the intended recipient that the second electronic message has been delivered to the supervisory recipient (Figure 2, elements 80,100 and 110, col. 3, lines 5-38, where the destination SMTP server determines whether the source client is on the accept or reject lists and if the source client is on the reject list, the e-mail message is deleted).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dieterman’s delivery of the electronic mail messages with the teachings of Heiner’s delivery of the electronic mail messages without notifying the intended recipient that the electronic message has been delivered to the supervisory recipient with a motivation to filter-out the junk e-mail messages received by the destination client and to reduce



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the amount of time spend by the destination client separating their regular e-mail messages from unwanted e-mail messages ( Heiner, col.1, lines 10-30).

6. **Claims 88-89, 101-102, 114-115** are rejected under 35 U.S.C. 103(a) as being unpatentable Dieterman and Heiner as applied to claims 78 and 104 above and further in view of prior art of record, Auvenshine ( U.S. Application No. 2004/0019650).

Dieterman as modified fails to teach wherein the electronic messages are instant messages (chat room messages) such that receiving electronic messages includes receiving instant messages transmitted across a delivery network from one or more sender devices and directed to the intended recipient.

However, Auvenshine is directed to a method, system and program for filtering communications received over a network for a person-to person communication program (i.e. instant message and chat room messages)[ abstract, see also page 2, paragraphs 17 and 26].

Auvenshine's system comprises a plurality of view programs and a filter program. The viewer program comprises application programs that enable users to view or transmit content, such as HTML, web browser newsgroup readers, word processing programs, etc., and communication software that allows person to person communication over the Internet (e.g. chat room software, AOL Messenger, ICQ, etc) .The filter program is capable of filtering content requested by the viewers in order to inhibit access to material deemed undesirable.

Auvenshine's filter program may be included within a gateway computer proxy server [ page 2, paragraph 28].

Auvenshine teaches logic implemented in the filter program to screen packets transmitted over the Internet destined for viewer programs , such as chat room program software, etc. (i.e.

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intended recipients. The filter program would process the packet and a predetermined list of words or phrases [page 4, paragraph 39].

Auvenshine further teaches logic implemented in the filter program to allow an administrator to set ratings for packets or documents that are rated acceptable, unacceptable or are rated for further consideration [page 4, paragraphs 40-42].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Dieterman as modified for controlling the delivery of electronic mail messages to incorporate the filter program of Auvenshine to also limit the ability of children to engage in inappropriate communications with adults on IRC chat lines and also help the businesses in limiting not only what employees cannot access, like the child filtering product, but also limiting what they can access [ page 1, paragraphs 6-9].

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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1/20/06